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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,138	12/31/2003	Scott W. Allan	PAT 51682A-2 US	6866
26123 7590 06/20/2007 BORDEN LADNER GERVAIS LLP WORLD EXCHANGE PLAZA 100 QUEEN STREET SUITE 1100 OTTAWA, ON K1P 1J9 CANADA			EXAMINER GATES, ERIC ANDREW	
			ART UNIT 3722	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/748,138

Applicant(s)

ALLAN ET AL.

Examiner

Eric A. Gates

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 19-30, 32 and 33 is/are rejected.
- 7) ☒ Claim(s) 18 and 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/31/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-30 and 32-34, drawn to a lock template assembly, classified in class 408, subclass 115R.
 - II. Claim 31, drawn to a lock installation kit, classified in class 206, subclass 373.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it does not require two side templates or self-alignment means. The subcombination has separate utility such as one which does not require it to form a case to a tool box.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if

any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Ms. L. Anne Kinsman on 7 June 2007 a provisional election was made without traverse to prosecute Invention I, claims 1-30 and 32-34. Affirmation of this election must be made by applicant in replying to this Office action. Claim 31 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the spring means of claim 10 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

8. Claim 10 is objected to because of the following informalities: in the phrase "template to a lie flush", the word "a" should be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 2, 4-8, 11, 12, and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Brydon (U.S. Patent 5,114,285).

11. Regarding claim 1, Brydon discloses a lock template assembly 10, comprising: an end template (70 and the immediate adjacent portions of sides 50 and 60) including a base portion 70 with at least one center hole 80 for alignment with a center line of a door edge when positioned on a door (see column 2, lines 58-61); at least one side template 50 (the portion not included in the end template) connected to the end template; biasing means (convergent sides as seen in figure 3, see column 2, lines 55-57) cooperating with the at least one side template to accommodate door edges of varied widths and to hold the at least one side template substantially flush to a respective door surface; and marking means 80 disposed in at least one side template for providing cylinder hole location.

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12. Regarding claim 2, Brydon discloses wherein the marking means 80 include guide holes.

13. Regarding claim 4, Brydon discloses wherein the biasing means include a resilient thermoplastic material (see column 3, lines 17-20).

14. Regarding claim 5, Brydon discloses wherein the end template is a generally U-shaped spring clip having two side portions forming the biasing means.

15. Regarding claim 6, Brydon discloses wherein the U-shaped spring clip applies substantially equal and opposing forces to the door to align the base portion with the center line (this is an inherent feature of the symmetrical clip).

16. Regarding claim 7, Brydon discloses having two side templates 50/60 (portions not included in the end template).

17. Regarding claim 8, Brydon discloses wherein the at least one side template 50 includes an offset tip (in as much as the tip of the template [edge away from the end portion 70] is offset from the end portion 70).

18. Regarding claim 10, Brydon discloses further including spring means for biasing the at least one side template to lie flush with respect to a respective door surface.

19. Regarding claim 11, Brydon discloses wherein the at least one side template and the end template are integrally formed.

20. Regarding claim 12, Brydon discloses wherein the biasing means is a spring clip 60 attached to the end template opposite to the at least one side template 50 (the opposite side template 60 functions as a spring clip in figure 3).

21. Regarding claim 15, Brydon discloses wherein the end template includes temporary fastener holes 80 for securing the template assembly to the door edge (the holes 80 in end portion 70 meet the structural requirement of this intended use limitation).

22. Regarding claim 16, Brydon discloses including further marking means 80 for providing a striker plate height and location on an adjacent doorjamb (the holes 80 in side portion 50 meet the structural requirement of this intended use limitation).

23. Regarding claim 17, Brydon discloses further including self-alignment means (the convergent sides as seen in figure 3 will self-align the template on a door) provided on at least one of the biasing means and the at least one side template to ensure proper alignment between the at least one of the biasing means and the at least one side template.

24. Claims 19-22, 24-26, 29, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Brydon (U.S. Patent 5,114,285).

25. Regarding claim 19, Brydon discloses an integrally formed lock template assembly 10, comprising: an end template (70 and the immediate adjacent portions of sides 50 and 60) including a base portion 70 with at least one center hole 80 for alignment with a center line of a door edge when positioned on a door (see column 2, lines 58-61); at least one side template 50 (the portion not included in the end template) integrally formed with the end template and substantially perpendicular to the base portion; biasing means (convergent sides as seen in figure 3, see column 2, lines 55-

57), integrally formed with the end template, cooperating with the at least one side template to accommodate door edges of varied widths and to hold the at least one side template substantially flush to a respective door surface; and marking means 80 disposed in at least one side template for providing cylinder hole location.

26. Regarding claim 20, Brydon discloses wherein the end template has two side portions forming a generally U-shaped spring clip, and wherein two side templates 50/60 (the portions not included in the end template) depend from each of two side portions of the end template, respectively.

27. Regarding claim 21, Brydon discloses wherein the U-shaped spring clip applies substantially equal and opposing forces to the door to align the base portion with the center line (this is an inherent feature of the symmetrical clip).

28. Regarding claim 22, Brydon discloses wherein the marking means 80 include guide holes.

29. Regarding claim 24, Brydon discloses wherein the biasing means include a resilient thermoplastic material (see column 3, lines 17-20).

30. Regarding claim 25, Brydon discloses having two side templates 50/60.

31. Regarding claim 26, Brydon discloses wherein the side templates 50/60 include offset tips for reducing effort required to operate the biasing means (in as much as the tips of the template [edges away from the end portion 70] are offset from the end portion 70, and the tips may be used to operate the biasing means by placing one template against the door frame and applying a force to separate the sides to allow the assembly to be placed onto the door).

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32. Regarding claim 29, Brydon discloses wherein the end template includes temporary fastener holes 80 for securing the template assembly to the door edge (the holes 80 in end portion 70 meet the structural requirement of this intended use limitation).

33. Regarding claim 30, Brydon discloses including further marking means 80 for providing a striker plate height and location on an adjacent door jamb (the holes 80 in end portion 70 meet the structural requirement of this intended use limitation).

34. Claim 32 is rejected under 35 U.S.C. 102(b) as being anticipated by Brydon (U.S. Patent 5,114,285).

35. Regarding claim 32, Brydon discloses a lock template assembly 10, comprising: an end template (70 and the immediate adjacent portions of sides 50 and 60) including a base portion 70 with at least one center hole 80 for alignment with a center line of a door edge when positioned on a door (see column 2, lines 58-61); at least one side template 50 (the portion not included in the end template) connected to the end template; biasing means (convergent sides as seen in figure 3, see column 2, lines 55-57) cooperating with the at least one side template to accommodate door edges of varied widths and to hold the at least one side template substantially flush to a respective door surface; and marking means 80 disposed in the at least one side template for marking a location of a striker plate on an adjacent door jamb when the side template is positioned adjacent the door jamb (the holes 80 in end portion 70 meet the structural requirement of this intended use limitation).

36. Claim 33 is rejected under 35 U.S.C. 102(b) as being anticipated by Brydon (U.S. Patent 5,114,285).

37. Regarding claim 33, Brydon discloses a lock template assembly 10, comprising: an end template (70 and the immediate adjacent portions of sides 50 and 60) including a base portion 70 with at least one center hole 80 for alignment with a center line of a door edge when positioned on a door (see column 2, lines 58-61); at least one side template 50 (the portion not included in the end template) connected to the end template; biasing means (convergent sides as seen in figure 3, see column 2, lines 55-57) cooperating with the at least one side template to accommodate door edges of varied widths and to hold the at least one side template substantially flush to a respective door surface; self-alignment means (the convergent sides as seen in figure 3 will self-align the template on a door) provided on at least one of the biasing means and the at least one side template to ensure proper alignment between the at least one of the biasing means and the at least one side template; and marking means 80 disposed in at least one side template for providing cylinder hole location.

Claim Rejections - 35 USC § 103

38. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

39. Claims 3 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brydon.

40. Regarding claims 3 and 23, Brydon discloses the invention substantially as claimed, except Brydon does not disclose wherein the biasing means include spring steel. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the clip from spring steel instead of plastic for the purpose of having a clip that is more resistant to breaking, because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

41. Claims 9, 13, 14, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brydon in view of Miller (U.S. Patent 5,249,336).

42. Regarding claims 9, 13, and 14, Brydon discloses the invention substantially as claimed, except Brydon does not disclose wherein the at least one side templates is pivotably connected to the biasing means, or wherein the at least one side template includes a non-marking protection cap, or further including grip means applied to an inside surface of at least one of the biasing means and the at least one side template.

Miller teaches the use of a clip 1 that comprises a clamping element 2 with opposed gripping means 5 that are pivotably connected to the clamping element for the purpose of using the gripping means to open the clamping element. The gripping means include sleeves 3/4 for the purpose of making it easier and more comfortable to grip the gripping means and for the purpose of preventing damage to the surface of the

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clamped item. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the assembly of Brydon with the pivoting gripping means and sleeves of Miller in order to have a lock template assembly that is easier to attach to the door in a manner which is more comfortable to the user and is less likely to damage the surface of the door, and which improves the grip of the side template to the surface of the door.

While the sleeves of Miller would could not be used in the shape disclosed by Miller, it would have been an obvious matter of design choice to make the different portions of the sleeves of whatever form or shape was desired or expedient, such as for the purpose of only covering the portions of the side templates not used for marking. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results.

43. Regarding claims 27 and 28, Brydon discloses the invention substantially as claimed, except Brydon does not disclose wherein the at least one side template includes a non-marking protection cap, or further including grip means applied to an inside surface of at least one of the biasing means and the at least one side template.

Miller teaches the use of a clip 1 that comprises a clamping element 2 with opposed gripping means 5 that are pivotably connected to the clamping element for the purpose of using the gripping means to open the clamping element. The gripping means include sleeves 3/4 for the purpose of making it easier and more comfortable to grip the gripping means and for the purpose of preventing damage to the surface of the clamped item. Therefore it would have been obvious to one having ordinary skill in the

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art at the time the invention was made to have combined the assembly of Brydon with the pivoting gripping means and sleeves of Miller in order to have a lock template assembly that is easier to attach to the door in a manner which is more comfortable to the user and is less likely to damage the surface of the door, and which improves the grip of the side template to the surface of the door.

While the sleeves of Miller would could not be used in the shape disclosed by Miller, it would have been an obvious matter of design choice to make the different portions of the sleeves of whatever form or shape was desired or expedient, such as for the purpose of only covering the portions of the side templates not used for marking. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results.

Allowable Subject Matter

44. Claims 18 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

45. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric A. Gates whose telephone number is 571-272-5498. The examiner can normally be reached on Monday-Thursday 7:45-6:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



EAG
13 June 2007


MONICA CARTER
SUPERVISORY PATENT EXAMINER